

Remarks

Claims 44 and 46 have been amended. Claims 45 and 49 have been cancelled without prejudice or disclaimer of the encompassed subject application.

The amendments to claims 44 and 46 narrow the scope of the claims and find representative support throughout the specification. Accordingly, Applicants submit that no prohibited new matter has been introduced by the amendments.

1. Response to Examiner's Answer

Without acquiescing to the merits of the rejection of the claims as iterated by the Examiner in the Examiner's Answer ("Answer") dated August 3, 2010, Applicants have narrowed the scope of the claims to expedite prosecution of the application. However, Applicants would like to clarify at least two misunderstandings by the Examiner regarding the claimed invention and accordingly respond to the following selected sections of the Answer.

A. Page 13, lines 6-8 of the Answer

In this section of the Answer, the Examiner attempts to rebut Applicants' submission that there is no motivation provided by Suzuki for a person of ordinary skill in the art to focus on adding a narrowly defined class of non-disclosed additives to a formulation of a benzamide compound when Savastano teaches that hundreds of excipients are equally suitable for use. The Examiner contends that "[t]his argument is not persuasive since instant claims recite 'an excipient selected from the group consisting of **lactose, lactose anhydride--**----', the very compounds which appellant argues that **degrade the benzamide compounds**" (page 13, lines 6-8).

In reply to this assertion by the Examiner, Applicants submit that page 6, lines 33-37 of the specification of the subject application clearly states that "When an organic acid salt, an amino compound or an inorganic basic substance is added, additives such as excipients,...and coating agents can be used without limitation. Examples include lactose, lactose anhydride, D-mannitol..." Although Table 1 of the subject application shows that lactose hastens degradation of a benzamide compound encompassed by Applicants' claims, Applicants have discovered that when an amino compound or an inorganic base substance is added, formerly unacceptable excipients such as lactose become acceptable and can be used

in benzamide formulations. Without this knowledge by Applicants, a person of ordinary skill in the art would not be able to prepare the claimed benzamide formulations.

B. Page 11, lines 20-22 of the Answer

In this section of the Answer, the Examiner states that “[i]t is interesting to note that these formulations in Table 2 contain only polyethylene glycol and the inorganic bases but none of the ingredients recited in the claims. Claims also do not recite polyethyleneglycol” (page 11, lines 20-22).

In reply to this statement by the Examiner, Applicants submit that claim 46 recites a benzamide compound, a solvent consisting of polyethylene glycol and at least one member selected from the group consisting of an organic acid salt, an amino compound and an inorganic base, wherein the inorganic base is at least one member selected from the group consisting of sodium carbonate, ammonium carbonate, sodium bicarbonate, potassium bicarbonate, disodium phosphate, and ammonia. Therefore, the Examiner is mistaken in indicating that the ingredients shown in Table 2 are “none of the ingredients recited in the claims.” Regarding the Examiner’s statement that the claims “do not recite polyethyleneglycol”, Applicants point to claims 46 and 47 which clearly recite polyethylene glycol. Applicants respectfully request that the Examiner reconsider the patentability of the claims as amended in view of this clarification.

2. Conclusion

Applicants respectfully request allowance of the claims as amended in view of the above amendments and remarks. If helpful to further prosecution of the subject application, the Examiner is invited to telephone the undersigned.

Except for issue fees payable under 37 C.F.R. 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. 1.16 and 1.17 which may be required, including any required extension of time fees, or to credit any overpayment to Deposit Account No. 50-0310.

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